



Paper No. 7

OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT PC
1755 JEFFERSON DAVIS HIGHWAY
FOURTH FLOOR
ARLINGTON VA 22202

COPY MAILED

MAR 04 2003

OFFICE OF PETITIONS

In re Application of
Allen, et al.
Application No. 10/024,225
Filed: December 21, 2001
Attorney Docket No. 209184US
Title: PHILLIPSITIC ZEOLITE SOIL
AMENDMENTS

DECISION GRANTING
PETITIONS AND MERGING
FILES

In re Application of
Allen, et al.
Application No. 10/193,699
Filed: July 11, 2002
Title: PHILLIPSITIC ZEOLITE SOIL
AMENDMENTS

This is a decision on the petitions filed September 4, 2002 in the above-identified applications, requesting that the substitute specification filed in Application No. 10/024,225 on July 11, 2002 be placed into that application file, and that Application No. 10/193,699 be canceled.

The petitions are GRANTED to the extent that the application files will be merged. However, the substitute specification will **not** be entered.

Application No. 10/024,225 was filed on December 21, 2001. On February 22, 2002, the Office of Initial Patent Examination (OIPE) mailed a Notice to File Missing Parts of Nonprovisional Application (Filing Date Granted), requiring an executed oath or declaration and a substitute specification containing proper margins. On April 22, 2002, applicant filed an executed declaration and a substitute specification containing proper margins.

On July 11, 2002, applicant filed an additional substitute specification, replacing the word "Jordanite" with the term "Yenomite". The submission contained a cover letter directed to

Application No. 10/024,225, a substitute specification marked with the word "Substitute", and a redline version marked "Redline Version".

OIPE entered the substitute specification into a new application file, Application No. 10/193,699. Thereafter, OIPE mailed a Notice to File Missing Parts (Filing Date Granted) for Application No. 10/193,699 on August 12, 2002. This Notice required an executed oath or declaration and the necessary filing fees.

The substitute specification was directed to Application No. 10/024,225, and was clearly labeled as a substitute specification. Therefore, it was an Office error to have entered the substitute specification into a new application file. Accordingly, it is appropriate to merge the files in order to correct an Office error. Given the basis for granting this decision, no petition fee has been charged.

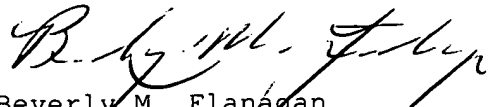
However, a review of the substitute specification does not reveal a statement that the substitute specification includes no new matter, as required by 37 CFR 1.125(b) (1). Accordingly, the substitute specification is improper.

If applicant desires to have the substitute specification entered, applicant should submit a statement to the examiner that the substitute specification includes no new matter. MPEP 608.01(q) states that "[t]here is no obligation on the examiner to make a detailed comparison between the old and the new specifications for determining whether or not new matter has been added. If, however, an examiner becomes aware that new matter is present, objection thereto should be made."

The applications will be returned to the Application Processing Division for merging the file of Application No. 10/193,699 into the file of Application No. 10/024,225. Application No. 10/193,699 will no longer be an active serial number. All future correspondence concerning this application should be directed to Application No. 10/024,225.

Application No. 10/024, 225 will then be forwarded to Technology Center 1600 for to await for applicant's submission of a statement that the substitute specification contains no new mater. At that time, the examiner will consider the substitute specification to determine if new matter is present.

Telephone inquiries concerning this matter may be directed to Petitions Attorney Cliff Congo at (703)305-0272.


Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions